

REMARKS

Applicants have further amended the Title to more clearly reflect the subject matter currently being claimed in the above-identified application.

Applicants have amended the Abstract, as submitted in the Amendment filed October 15, 2003, to more clearly reflect the subject matter in the technical disclosure of the above-identified application. Specifically, the Abstract as presently amended indicates that the application discloses a system which has an electric device that functions in the system both as an electric motor for supplying power to machines and as a generator to generate electric power. The Abstract as presently amended indicates that the system includes an outside source of mechanical power which powers the electric device to act as a generator to generate electricity. Consistent with the present disclosure, this Abstract also sets forth that the electric device includes a stator and rotor, with a laminated iron core.

Applicants have amended their specification, as compared with the previously submitted Substitute Specification submitted with the Amendment filed October 15, 2003, in order to further clarify the definition of various aspects of the present invention. In connection therewith, Applicants respectfully traverse the refusal by the Examiner to enter the Substitute Specification submitted on October 15, 2003, "because it does not conform to 37 CFR § 1.125(b) and (c)". Please note that in the Office Action mailed May 15, 2003, the Examiner required a Substitute Specification. Note Item 6 on page 3 of the Office Action mailed May 15, 2003. Thus, it is respectfully submitted that the Substitute Specification filed on October 15, 2003, was filed under 37 CFR § 1.125(a), not

37 CFR § 1.125(b). Accordingly, it is respectfully submitted that the Examiner must enter the Substitute Specification filed on October 15, 2003. Based upon entry of the Substitute Specification submitted October 15, 2003, the present amendments to this substitute Specification submitted October 15, 2004, are clearly proper.

Applicants have further amended the specification, in light of issues raised by the Examiner in, inter alia, Items 4 and 5 on pages 2 and 3 of the Office Action mailed December 11, 2003. Please note that for the convenience of the Examiner, and in addition to the Further Substitute Specification submitted as an Appendix hereto, also enclosed is a copy of the Substitute Specification filed on October 15, 2003, with amendments handwritten thereon; as can be appreciated, the amendments herein include amendments to the Substitute Specification filed October 15, 2003, handwritten on the enclosed copy thereof.

Thus, note that the presently submitted Further Substitute Specification describes that the present invention relates to a system respectively having a function for driving machines and having an electrical power generation function. As presently amended, the invention is described as a system having an electric device which functions as an electric motor (that is, the device is an electric motor when electrical power is applied thereto); and, moreover, the device, when, e.g., mechanical power is applied thereto, functions as an electrical power generator and is used to generate electrical power and connected in an electric power line.

Applicants are amending their claims in order to further clarify the definition of various aspects of the present invention. Specifically, each of claims 11 and 18, the sole independent claims being considered on the merits in the above-identified

application, has been amended to recite a system having an electric device which functions both as an electric motor for driving machines and as a generator to generate electric power (or as a generator for electrical power generation). Claims 11 and 18 have been amended to recite that the system includes this electric device, with this device having structure to function as an electric motor for driving a machine. Claim 11 has been further amended to recite a power source for driving the electric device, and that when the power source supplies mechanical power to the electric device, the device functions as an electrical generator to generate electrical power, whereby the electric device can function as an electric motor to drive machines and as a generator to generate electrical power. Claim 18 has been further amended to recite a first power source for supplying electrical power to the electric device such that the device functions as an electric motor, with the first power source supplying electric power to the electric motor such that the electric motor generates mechanical power, whereby the electric motor can drive machines.

The dependent claims previously considered on the merits in the above-identified application, claims 12-17 and 19, have been amended in light of amendments to the independent claims.

Initially, it is respectfully requested that the present amendments be entered. Noting, for example, clarification of the bases for the objections and rejections as set forth in the Office Action mailed December 11, 2003, it is respectfully submitted that the present amendments are clearly timely; and, moreover, clearly materially limit any issues remaining in the above-identified application. At the very least, it is respectfully submitted that the present amendments present the claims in better

form for consideration, including better form for appeal. Moreover, noting especially that the present amendments clarify the definition of the present invention, it is respectfully submitted that the present amendments do not raise any new issues, including any issue of new matter, and should be entered so as to advance prosecution in connection with the above-identified application such that an examination on the merits of the above-identified application, and, in particular, a prior art search, is performed.

It is respectfully submitted that the foregoing sets forth the necessary showing under 37 CFR § 1.116; and, accordingly, entry of the present amendments is clearly proper.

Objection to the Abstract as set forth in Item 2 on page 2 of the Office Action mailed December 11, 2003, is noted. It is respectfully submitted that this objection is moot, in view of the newly submitted Abstract.

The allegation by the Examiner that the Title of the invention is not descriptive and the requirement for a new title, set forth in Item 3 on page 2 of the Office Action mailed December 11, 2003, is noted. It is respectfully submitted that the amended title as set further herein is clearly indicative of the invention to which the claims being considered on the merits in the above-identified application are directed, such that the requirement for a new title has been satisfied.

The objection to the disclosure under 37 CFR § 1.71, set forth in Item 4 on page 2 of the Office Action mailed December 11, 2003, is noted. As further clarified in the Further Substitute Specification submitted herein, it is respectfully submitted that the present invention is sufficiently clearly set forth to satisfy all requirements of

the first paragraph of 35 USC §112 and of 37 CFR § 1.71. Thus, note that the disclosure as presently amended describes that the present invention includes an electric device functioning respectively both as an electric motor for driving machines and as an electrical generator in an electrical power generation system; and, in particular, functions as an electric motor when electrical power is supplied thereto; and, when mechanical power is applied thereto, functions as an electrical power generator. Specific embodiments according to the present invention are described in connection with Figs. 1(A) and 1(B), as well as in connection with Figs. 2(A) and 2(B), these figures including comparisons with the prior art as described, for example, on page 1 of the enclosed Further Substitute Specification. Note especially pages 8-11 of the enclosed Further Substitute Specification. It is respectfully submitted that in view of the enclosed Further Substitute Specification, the objection to the disclosure under 37 CFR § 1.71, as set forth in Item 4 on page 2 of the Office Action mailed December 11, 2003, is moot.

The phrase not understood by the Examiner, as set forth in the first paragraph of Item 4, on page 2 of the Office Action mailed December 11, 2003, is noted. As presently amended, it can be seen that the description of the present invention discloses a system with "an electric device" respectively functioning as an electric motor and as an electrical generator, with an outside power source (for example, another electric motor, an internal combustion engine, or wind power or hydraulic power from outside) being used to provide power to the electric device so that the electric device functions to generate electrical power (that is, as an electrical generator). Thus, as presently amended, and in particular in view of the description

that the system includes "an electrical device", any question with respect to power generation being carried out in a power source such as an electric motor, insofar as electrical power generation is concerned, is moot.

The issues a)-h) under Item 5, set forth on page 3 of the Office Action mailed December 11, 2003, are noted. In view of the presently submitted Further Substitute Specification, it is respectfully submitted that the issues raised therein are moot. Thus, as compared with the previously submitted Substitute Specification filed on October 15, 2003, the presently submitted Further Substitute Specification describes an electric device functioning respectively both as an electric motor for driving machines and as an electrical generator in an electrical power generation system, wherein, in this electrical power generation system, another electric motor an internal combustion engine, or wind power or hydraulic power from outside (that is, external, e.g., mechanical power) is utilized to provide power to the device, thereby an electrical power generation function can be obtained. In addition, it is respectfully submitted that the disclosure as a whole is clear with respect to the electric motor driving machines such as a compressor or machine tool.

In connection with the phrase "generator carries out switch-on operation", it is respectfully submitted that the disclosure as presently amended is clear that such switch-on operation switches the device from a generator to an induction motor "excited on an electric power system line or an alternating current"; that is, by such switching, the electric device switches from a generator to an electric (induction) motor, which can drive a machine.

Comments by the Examiner with respect to the description of Figs. 1A, 1B,

2A and 2B on pages 4 and 5 of the Substitute Specification filed October 15, 2003, are noted. Such descriptions have been modified in the presently submitted Further Substitute Specification, and it is respectfully submitted that the description therein is sufficiently clear. Similarly, it is respectfully submitted that the phrases set forth in f)-h) on page 3 of the Office Action mailed December 11, 2003, are clear, especially as amended in the enclosed Further Substitute Specification. Thus, it is respectfully submitted to be clear from the description that according to the prior art the electrical device described was used merely to drive machines (for example, provide mechanical power to drive a compressor or turbine), and not to generate electrical power. According to the present invention, an electric device is used not only to supply mechanical power, as an electric motor, but can also be used when supplied with mechanical power, e.g., from an outside power source, as an electrical generator in an electric power generation system.

Reference by the Examiner to "a prime mover in the outside portion", in h) of Item 5 on page 3 of the Office Action mailed December 11, 2003, is noted. Such "prime mover", as is clear from the description in connection with Figs. 1A and 1B, is an external power source for supplying, e.g., mechanical power to the electrical device.

In view of all of the foregoing, entry of the enclosed Further Substitute Specification, and reconsideration and withdrawal of objections to the specification, are respectfully requested.

The rejection of the claims under the first paragraph of 35 USC §112, as failing to comply with the enablement requirement, set forth in Item 7 on page 4 of

the Office Action mailed December 11, 2003, is respectfully traversed, especially insofar as applicable to the claims as presently amended. Thus, the claims as presently amended recite that the system includes (a) an electric device that can function respectively as an electric motor and as an electrical generator, and (b) a power source such that when the power source is connected to the electric device to drive the electric device the electric device acts as an electrical generator. The structure for the system such that the electric device can act, respectively, as an electric motor and as an electrical generator, is set forth in the disclosure. In view thereof, it is respectfully submitted that an enabling disclosure is provided.

Particularly in view of, inter alia, the embodiments shown in Figs. 1B and 2B, and the descriptive matter provided in connection therewith, an enabling disclosure is provided in the disclosure, for the presently claimed invention.

It is noted that the Examiner sets forth no basis for the rejection under 35 USC §112, first paragraph, as failing to comply with the enablement requirement, other than stating that the claims "are incomprehensible". It is not seen how this statement by the Examiner qualifies as a basis for rejection of claims under the first paragraph of 35 USC §112, as failing to comply with the enablement requirement. It is respectfully submitted that the burden is on the Examiner for establishing a failure to comply with the enablement requirement of the first paragraph of 35 USC §112. See in re Bowen, 181 USPQ 48 (CCPA 1974); and in re Dinh-Nguyen, 181 USPQ 46 (CCPA 1974). The Examiner has failed to satisfy this burden.

In any event, especially in view of the present amendments to the claims, it is respectfully submitted that the disclosure of the above-identified application



satisfies requirements of the first paragraph of 35 USC §112, in connection with the presently claimed subject matter.

The rejection of claims 11-19 under the second paragraph of 35 USC §112, as being indefinite, set forth in Item 9 on page 4 of the Office Action mailed December 11, 2003, is moot. In view of the present amendments to the claims, particularly claims 11 and 18, it is respectfully submitted that the various bases for rejection of the claims under the second paragraph of 35 USC §112 are moot.

In particular, it is respectfully submitted that, particularly as presently amended, the recitation of the motor as having structure for driving machines is sufficiently definite to satisfy requirements of the second paragraph of 35 USC §112. Thus, particularly in light of the description in Applicants' specification, it is clear that the electric motor drives a machine such as a compressor and machine tools; and, moreover, has structure for performing this function. It is respectfully submitted that one of ordinary skill in the art would know whether a device having various components, would include structure for driving a machine, such that the present claims are not indefinite.

Similarly, recitation of the power source or driving motor for supplying mechanical power to the electrical device as in the present claims further defines the various structures and relationships therebetween, so as to define a system with sufficient particularity such that one of ordinary skill in the art would know whether any specific system fell within or outside of the present claims. Under the present circumstances, it is respectfully submitted that the second paragraph of 35 USC §112 requires nothing more. See in re Moore, 169 USPQ 236 (CCPA

1971).

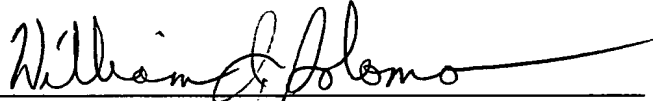
Reference by the Examiner to claims "2-17 and 19" as being indefinite because they depend on the rejected claim and do not correct the noted problem, is noted. Suffice it to say that claims 2-10 do not depend on the rejected claim, and, moreover, are not being considered on the merits in the present application. In view thereof, reference to claims 2-10 in connection with the indefiniteness rejection is not understood.

In view of the foregoing comments and amendments, entry of the present amendments, and reconsideration and allowance of all claims presently in the application, are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 840.40130X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "William I. Solomon", written over a horizontal line.

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